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07-1595

Supreme Court, U.S.
FILED
AUG 2 2 2008
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IN THE

Supreme Court of the United States

STEPHEN G. GOETZ and GARDNER DESIGN GROUP, LLC,

Petitioners,

—against—

AMERICAN EXPRESS CO.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

Whether the Second Circuit entered any decision on the issue of the evidentiary burden required to establish secondary meaning in a reverse confusion case that conflicted with the decision of another United States court of appeals and whether the decision is worthy of this Court's review. Notably, (i) the issue was not raised nor decided below; (ii) Petitioners confuse the analogous use doctrine, used to establish priority of rights through use in commerce, with secondary meaning, which is used to establish the protectability of a trademark; (iii) Petitioners point to no real conflict on the analogous use doctrine nor on the standards for secondary meaning; and (iv) any resolution of this alleged conflict would be immaterial to the outcome of this litigation.

Whether the District Court's denial of Petitioners' overbroad and speculative request for discovery relating to Petitioners' misappropriation claim, which Petitioners dropped from the case, was an egregious departure from the accepted and usual course of judicial proceedings warranting this Court's supervisory power where the requested discovery had no bearing on the ultimate issues which the Court found dispositive in dismissing Petitioners' claims and any alleged error has significance only to the particular facts of this case.

RULE 29.6 STATEMENT

American Express Company states that it has no parent corporation and that the following publicly held companies own 10% or more of its stock: Berkshire Hathaway, Inc.

TABLE OF CONTENTS

PAGE

QUESTIONS PRESENTED i

RULE 29.6 STATEMENT ii

TABLE OF CONTENTS iii

TABLE OF AUTHORITIES v

STATEMENT OF THE CASE 1

REASONS FOR DENYING THE PETITION 5

A. The Decisions Below Did Not Implicate any Allegedly "Inconsistent Burden on a Reverse Confusion Claimant" and Do Not Create Any Circuit Split 7

I. Petitioners' First Question Does Not Warrant this Court's Review Because it was Not Raised or Decided Below and Would Not Change the Outcome of this Action 7

II. Petitioners Mischaracterize the Decisions Below and the Decisions Regarding an Alleged Circuit Split..... 10

PAGE

B. The District Court's Discretionary and Proper Denial of Petitioners' 56(f) Motion Does Not Warrant Exercise of this Court's Supervisory Power 14

I. The Denial of Petitioners' 56(f) Motion is Primarily a Question of Fact and Sufficiency of Evidence Relevant Only to the Parties and Does not Warrant Review by this Court 14

II. No Discovery was Needed from Respondent on the Ground that the District Court Granted Summary Judgment and Thus Any Alleged Error in Denying Petitioners' 56(f) Motion Was Harmless 17

CONCLUSION 20

TABLE OF AUTHORITIES

Federal Cases: PAGE

Adarand Constructors, Inc. v. Mineta, 534 U.S. 103 (2001) 8

Ariz. Dep't of Revenue v. Blaze Constr. Co., 526 U.S. 32 (1999)..... 18

Celotex Corp. v. Catrett, 477 U.S. 317 (1986) 15, 18

City of Springfield v. Kibbe, 480 U.S. 257 (1987) 8

Cohn v. Petsmart, Inc., 281 F.3d 837 (9th Cir. 2002) 13

Commerce Nat'l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc., 214 F.3d 432 (3d Cir. 2000)..... 12-13

Cooper Indus., Inc. v. Aviall Servs., Inc., 543 U.S. 157 (2004) 8

Dick's Sporting Goods, Inc. v. Dick's Clothing & Sporting Goods, Inc., No. 98-1653, 1999 U.S. App. LEXIS 19942 (4th Cir. Aug. 20, 1999)..... 13

Flowers v. United States Army, 127 S. Ct. 2248 (2007)..... 14

Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U.S. 271 (1949) 16

Gurary v. Winehouse, 190 F.3d 37 (2d Cir. 1999) 18-19

PAGE

Layne & Bowler Corp. v. Western Well Works, 261 U.S. 387 (1923) 16-17

Magnum Imp. Co. v. Coty, 262 U.S. 159 (1923) 16

National Labor Relations Bd. v. Pittsburgh Steamship Co., 340 U.S. 498 (1951) 16

Paddington Partners v. Bouchard, 34 F.3d 1132 (2d Cir. 1994) 19

Rice v. Sioux City Mem'l Park Cemetery, Inc., 349 U.S. 70 (1955) 6

Sommerville v. United States, 376 U.S. 909 (1964) 8

Southern Power Co. v. North Carolina Pub. Serv. Co., 263 U.S. 508 (1924) ... 15

Standard-Vacuum Oil Co. v. United States, 339 U.S. 157 (1950) 8

T.A.B. Sys. v. PacTel Teletrac, 77 F.3d 1372 (Fed. Cir. 1996) 11

The Monrosa v. Carbon Black Export, Inc., 359 U.S. 180 (1959) 8-9

United States v. Galletti, 541 U.S. 114 (2004) 8

United States v. Johnston, 268 U.S. 220 (1925) 15

PAGE

Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000) 11

Ying Gan v. The City of N.Y., 996 F.2d 522 (2d Cir. 1993)..... 19

Youakim v. Miller 425 U.S. 231 (1976) 8

Miscellaneous:

E. Gressman, K. Geller, S. Shapiro, T. Bishop & T. Hartnett, Supreme Court Practice § 4.4(h) (9th ed. 2007) 8

E. Gressman, K. Geller, S. Shapiro, T. Bishop & T. Hartnett, Supreme Court Practice § 6.37(i)(3) (9th ed. 2007) 7

2 J. Thomas McCarthy, *McCarthy on Trademark and Unfair Competition* §§ 15:1-82 (4th ed. 2008)..... 12

3 J. Thomas McCarthy, *McCarthy on Trademark and Unfair Competition* § 20:16 (4th ed. 2008) 11

STATEMENT OF THE CASE

Pursuant to Rule 15, Respondent addresses the many misstatements of fact in the petition that bear on what issues properly would be before the Court if certiorari were granted. Respondent also incorporates by reference the facts and proceedings as set forth in the decisions of the District Court and Second Circuit, the Joint Appendix on appeal, as well as in Respondent's submissions to the courts below.

The facts in the Record established that in July of 2004, the American Express Company ("Amex"), through Ogilvy & Mather ("Ogilvy"), its advertising agency, was in the midst of developing a new global advertising campaign (the "Global Campaign"). By mid-July, Ogilvy had developed the service mark MY LIFE. MY CARD. ("MLMC") as a possible theme for the Global Campaign. By late July, Ogilvy had presented memoranda and scripts to Amex using the MLMC theme and had asked for, and received preliminary results for, trademark searches for the mark. During the course of discovery, Amex and Ogilvy produced numerous such documents (including handwritten notes, emails and attached documents referring to MLMC, and searches conducted by outside trademark counsel) reflecting that Amex and Ogilvy had independently conceived of the MLMC mark as early as July 15, 2004. Indeed, even Petitioners admit in their submission to this Court that there were documents reflecting Amex's independent conception of MLMC dated at least as early as July 22nd.

Petitioners claimed that near this time Mr. Goetz came up with a concept to develop software which would allow consumers to personalize their credit cards. In late July, Goetz sent out letters (the "proposal") to two credit card companies, Amex and MasterCard. The proposal was on the letterhead of a third party, Mez Design, and, at best, offered to license the words "*My Life, My Card!*" for the credit card companies to use in conjunction with their offering credit card personalization services. This is indicated by the fact that these words are followed by the statement "American Express [or Mastercard] delivers personalized cards to its cardholders!" The proposal was sent to Amex on July 30, 2004 via UPS, to be delivered on August 2, 2004, which Petitioners admit was the earliest date Amex received it. There is no evidence that any consideration was given to this proposal or that it was even viewed.

Amex began using the MLMC service mark on November 8, 2004, through its launch of the Global Campaign via, *inter alia*, print, TV, and internet advertising. In the meantime, Petitioners had not used *My Life, My Card* as a trademark in connection with any goods or services offered by them or used it in commerce, nor have they done so to date. Prior to Amex's use, Petitioners had not even developed a product or service. Instead, Petitioners' stated intent was to offer to license *My Life, My Card* to credit card companies for *their* use in connection with offering credit card personalization services. At most, to further this intent, Goetz had sent out the proposal described above to Amex and MasterCard,

put together a pitch to MasterCard regarding a future product or service in the form of a Demo that was hosted on a password-protected webpage, and registered a domain name that was not in use.

In February 2005, Amex filed a Complaint for Declaratory Judgment, seeking a declaration that it had not misappropriated or infringed any purported rights in *My Life, My Card* and that Amex's rights were superior to Petitioners' purported rights, if any. During the course of discovery, it became abundantly evident that not only had Amex and Ogilvy independently created the MLMC service mark and used it prior to any use by Petitioners, but also Petitioners had no rights and no use at all in their purported mark. Amex, therefore, brought a motion for summary judgment in October 2005, following months of discovery, requesting a declaration that its rights in MLMC were superior to Petitioners and that it had not misappropriated any rights belonging to Petitioners. Among other things, Amex argued that Petitioners had not used the proposed slogan as a trademark to identify themselves as a source of goods and services, that Petitioners had not used the proposed slogan in commerce, and that there was no likelihood of confusion between Amex's use and Petitioners purported use.

Prior to Amex's summary judgment motion, Petitioners had filed a motion to compel seeking production of almost 30 hard drives belonging to Ogilvy employees. Following Amex's summary judgment motion, Amex sought a stay of discovery pending disposition of its motion, because none of the additional discovery sought by Petitioners

regarding Amex and Ogilvy's independent creation had any bearing on Petitioners' lack of use and trademark rights. Petitioners made a motion under 56(f) to continue the motion, solely speculating on the veracity of the declarants and the authenticity of the documents presented in support of Amex's summary judgment motion. The district court properly denied Petitioners 56(f) motion and granted a stay of discovery; it also denied Petitioners from "wholesale rummaging" into Ogilvy's electronic records, although it allowed Petitioners to verify the creation dates of two documents whose dates Petitioners challenged. The creation dates of these documents were ultimately corroborated by dated emails that attached the documents, which were examined by Petitioners' forensic expert. Significantly, in opposition to Amex's summary judgment motion, Petitioners dropped their misappropriation claims. Therefore, Petitioners themselves rendered superfluous the discovery they claim they were egregiously denied.

The District Court properly entered summary judgment for Amex because, based on undisputed facts, there was no evidence that Petitioners had used their proposed slogan to identify themselves as the source of goods or services (use as a trademark), and thus had no valid protectible trademark rights that Amex could have infringed. Petitioners filed a motion to amend the judgment, without any proper basis, which was denied. The Second Circuit, reviewing the infringement issue *de novo*, affirmed the District Court's decision. Petitioners misstate the Second Circuit's clear holding—a heading in its opinion—that

"Goetz did not use the slogan as a trademark," misleadingly characterizing the Second Circuit's description of Petitioners' preliminary activities with respect to offering the slogan to others as acknowledgement that Petitioners had undisputedly "used" the mark in connection with his "products and personalized credit card services." Petitioners' Brief at 3-4. Although the infringement claims could be disposed on this ground alone, the Second Circuit also found that Petitioners had not established trademark rights because they had not used the proposed slogan in commerce either through actual or analogous use. The Second Circuit also properly found that the District Court had not abused its discretion by limiting discovery and not allowing Petitioners unfettered access to Amex and Ogilvy employees. Once again, without any proper basis, Petitioners filed a motion for reconsideration, which was denied. Neither the District Court nor the Second Circuit addressed any question regarding secondary meaning. Yet again, by filing this baseless petition for writ of certiorari, it appears that Petitioners are determined to exhaust every judicial resource, regardless of whether they meet the criteria for the type of review they seek and regardless of the merits of their position.

REASONS FOR DENYING THE PETITION

The decision below does not conflict with any decision of any court of appeals; in fact, the first question presented by the Petitioner was not even raised nor decided in the proceedings below, and answering it would not change the outcome.

The District Court's proper exercise of its discretion to stay discovery pending summary judgment, which it granted, and denial of Petitioners' request for a continuance under 56(f), rested on its determination of the sufficiency of evidence on the issues presented, is a question of fact relevant only to the parties, and does not rise to an egregious departure from the accepted and usual course of judicial proceeding warranting an exercise of this Court's supervisory power. At worst, the asserted error was an erroneous factual finding or a misapplication of a properly stated rule of law, and was harmless.

Thus, the reasons for review presented by the Petitioner are not of the character the Court considers, as illustrated by Rule 10 of the Supreme Court Rules. Instead, Petitioners' two questions are each of the nature that this Court has identified as unworthy of review—the first "academic," and the second "episodic." *Rice v. Sioux City Mem'l Park Cemetery, Inc.*, 349 U.S. 70, 74 (1955) (dismissing a writ of certiorari as improvidently granted, and stating that the Court "does not sit to satisfy a scholarly interest . . . [n]or does it sit for the benefit of the particular litigants"). Therefore, there is no compelling reason for this Court to review this case, and the Petition should be denied.

A. The Decisions Below Did Not Implicate any Allegedly "Inconsistent Burden on a Reverse Confusion Claimant" and Do Not Create Any Circuit Split

I. Petitioners' First Question Does Not Warrant this Court's Review Because it was Not Raised or Decided Below and Would Not Change the Outcome of this Action

The Petitioners' first question regards a purported decision by the Second Circuit on the burden of proof placed on a reverse confusion claimant to establish secondary meaning that allegedly conflicts with decisions of other circuits. Critically, this issue was neither argued nor decided by either the district or the circuit court below and would not affect the outcome of this case. As a leading commentator has observed:

> In a surprisingly large number of cases every year, the petition raises questions that were not decided by the court below because they were not raised, or seriously mischaracterizes the holding of the court. Demonstration of such a defect is ordinarily fatal to the petition.

E. Gressman, K. Geller, S. Shapiro, T. Bishop & T. Hartnett, Supreme Court Practice, § 6.37(i)(3), at 506 (9th ed. 2007).

For the first time, Petitioners argue that the burden on a reverse confusion claimant to establish that its mark was associated in a significant quantity of the consuming public as referring

exclusively to the appropriate party, i.e., that it has secondary meaning, should be lowered. This Court, however, "ordinarily do[es] not decide in the first instance issues not decided below." *Cooper Indus., Inc. v. Aviall Servs., Inc.*, 543 U.S. 157, 168 (2004), quoting *Adarand Constructors, Inc. v. Mineta*, 534 U.S. 103, 109 (2001). See *United States v. Galletti*, 541 U.S. 114, 120 n.2 (2004) ("Respondents have forfeited this argument by failing to raise it in the courts below."); *City of Springfield v. Kibbe*, 480 U.S. 257, 258-59 (1987). Moreover, arguments not previously asserted are waived and cannot constitute a reason for granting a writ of certiorari. See also *Youakim v. Miller*, 425 U.S. 231, 234 (1976) ("Ordinarily, this Court does not decide questions not raised or resolved in the lower court") (citations omitted)); *Standard-Vacuum Oil Co. v. United States*, 339 U.S. 157, 160 (1950) ("We will not review questions not clearly raised on the record."). Indeed, the words "reverse confusion" or "secondary meaning" do not even appear in either courts' decisions.

Further, resolution of any alleged circuit split on the issue of the burden of establishing secondary meaning in reverse confusion cases will have no bearing on the outcome of this case. Certiorari is ordinarily denied in cases where the resolution of the alleged conflict in authority is irrelevant to the ultimate outcome of the action before this Court. See Gressman, *supra*, § 4.4(h), at 248 (*citing Sommerville v. United States*, 376 U.S. 909 (1964)). As this Court observed in *The Monrosa v. Carbon Black Export, Inc.*, 359 U.S. 180, 184 (1959), "[w]hile this Court decides ques-

tions of public importance, it decides them in the context of meaningful litigation."

As the District Court set forth in its Oral Ruling, the issue of alleged infringement turned upon "whether Goetz has any trademark rights at all. If he does, whether they are senior to those of American Express and if they are whether there is any likelihood of confusion." (App. 20a). The District Court explicitly resolved the case on the basis of the first question alone, and refused to reach the other issues, stating that its determination that Petitioners did not have trademark rights was for the simple reason that they did not use it as a source identifier for themselves but rather "it was used in the context of an invitation to the viewers to license [the] slogan from Goetz for their own use". (Id. at 23a). Thus, it never addressed the issue of secondary meaning, the burden on a reverse confusion plaintiff, or the "public". In fact, the District Court found that Petitioners could not "possibly prevail here even without regard to whether there is a question concerning the extent to which the uses on the websites were publicly available." (Id. at 24a). Similarly, the Second Circuit affirmed the District Court's dismissal based on Petitioners' failure to use the slogan to identify themselves as the source or origin of goods or services alone, finding that, similar to an advertising agency, Petitioners only presented the slogan "My Life, My Card" as a creative concept for others to use. (Id. at 6a-10a). Although the Second Circuit chose to address the second step of the analysis, and correctly determined that Petitioners had not established a priority of rights through using

the mark in commerce, or through analogous use, because their services were purely hypothetical, deliberately private, and never culminated in eventual actual use, it, too, did not address any "burden on a reverse confusion claimant" in establishing secondary meaning. (Id. at 10a-12a). Finally, although neither of the courts below found it necessary to address the third step of the infringement analysis, the infringement claims can also be resolved in Amex's favor by a finding that there is no likelihood of confusion between Amex's use and Petitioners' use (if any), as Amex argued below.

In sum, regardless of a resolution of the evidentiary burden required to establish secondary meaning, and even if an alleged conflict were resolved in the manner Petitioners urge, a finding of no infringement by Amex would still stand because Petitioners had no use as a trademark, no use in commerce (which is not the same as secondary meaning), and because there is no likelihood of confusion. Thus, review by this Court is unwarranted in this case because it can be, and has been, resolved on other grounds.

II. Petitioners Mischaracterize the Decisions Below and the Decisions Regarding an Alleged Circuit Split

Petitioners improperly confuse and attempt to equate the doctrines of analogous use and secondary meaning. Although both doctrines do indeed ultimately bear on the question of whether trademark rights have been established and infringed, they do so in different contexts. The Second Circuit's pronouncements regarding analogous use

cannot be interpreted as making any decision regarding the evidentiary burden required to establish secondary meaning in a reverse confusion case.

The analogous use doctrine, as explained by the Second Circuit, eases the technical requirements for establishing use in commerce in order to determine the priority of rights between competing claimants. (App. 10a-12a); *see also* 3 J. Thomas McCarthy, *McCarthy on Trademark and Unfair Competition* § 20:16 (4th ed. 2008). Petitioners do not argue that there is any circuit split on the doctrine of analogous use, and, although this Court has not ruled on the analogous use doctrine, there is no inconsistency in its application among the circuit courts that requires review by this Court. *See, e.g., T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 1376 (Fed. Cir. 1996) ("An unbroken line of precedents of both this court and the [Trademark Trial and Appeals] Board make clear that activities claimed to constitute analogous use must have substantial impact on the purchasing public.").

Secondary meaning, on the other hand, as this Court has explained before, is looked at in determining whether a trademark that is not inherently distinctive is worthy of protection. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000) ("a mark has acquired distinctiveness, even if it is not inherently distinctive, if it has developed secondary meaning, which occurs when in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself") (internal quotations and citations omit-

ted). *See generally* 2 McCarthy, *supra*, §§ 15:1-82. Whether or not the words "My Life My Card" are inherently distinctive such that they require secondary meaning was not a disputed or relevant issue in the proceedings below. Petitioners themselves did not raise the issue of secondary meaning in their papers opposing summary judgment, and argued it only on their appeal (although even then they did not advance any argument regarding the burden of establishing secondary meaning in a reverse confusion case and only do so for the first time before this Court). In opposition to Petitioners' appeal to the Second Circuit, Amex pointed out that it had never disputed that "*My Life, My Card*" for credit card or card personalization services was an inherently distinctive mark that did not require secondary meaning in order to be protectible *if used as a trademark*; rather, Amex's argument was that Petitioners had not shown any evidence that they had used such a mark to indicate themselves as the source of goods or services, and had not used the mark in commerce. Thus, the decisions below did not require Petitioners to show any amount of secondary meaning.

As for the alleged circuit split regarding the burden of establishing secondary meaning on a reverse confusion plaintiff, not only is this question irrelevant to the issues in this case, the alleged split between the Second Circuit and the Third Circuit, whose standard Petitioners urge this Court to adopt, is entirely concocted. Amazingly, this is revealed by the fact that the very proposition in *Commerce Nat'l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.* that Petitioners urge

this Court to adopt over the Second Circuit's allegedly conflicting view, cites as authority a Second Circuit and Southern District case. 214 F.3d 432, 444 (3d Cir. 2000) (finding that secondary meaning had been established by thirteen years of continuous use). *Dick's Sporting Goods, Inc. v. Dick's Clothing & Sporting Goods, Inc.*, an unpublished opinion from the Fourth Circuit lacking precedential value and thus uncertworthy, in turn, cites to the Third Circuit in explaining the doctrine of reverse confusion; in it, the Fourth Circuit merely notes that it had not had occasion to adopt the doctrine of reverse confusion to date and that it was not applicable to the case at hand. No. 98-1653, 1999 U.S. App. LEXIS 19942, at *34 (4th Cir. Aug. 20, 1999). In the only other decision cited by Petitioners as evidencing a circuit split, *Cohn v. Petsmart, Inc.*, the Ninth Circuit referenced the issue of secondary meaning in dicta and drew a comparison to *Commerce Nat'l*, but did not rule on the issue of the amount of secondary meaning required in a reverse confusion case because, similar to this case, the protectability of the mark was not disputed. 281 F.3d 837, 842 n.6 (9th Cir. 2002) ("Although Cohn's use of the mark is weak, Petsmart does not argue that Cohn's mark is undeserving of protection because it lacks secondary meaning"). Thus, none of these cases presents a true conflict on the issue for this Court to resolve.

Such irresponsible presentation of the holdings in the cases below and those cited in Petitioners' Brief as supporting authority reveal that not only do the issues not warrant this Court's review, but

that if there were a true and irreconcilable circuit split, Petitioners present the issues in a manner that would make this case a poor vehicle for resolving such a conflict.

B. The District Court's Discretionary and Proper Denial of Petitioners' 56(f) Motion Does Not Warrant Exercise of this Court's Supervisory Power

I. The Denial of Petitioners' 56(f) Motion is Primarily a Question of Fact and Sufficiency of Evidence Relevant Only to the Parties and Does not Warrant Review by this Court

This Court has already determined that the question regarding a district court's denial of a 56(f) motion does not merit review. In *Flowers v. United States Army*, 127 S. Ct. 2248 (2007), this Court denied a certiorari petition requesting review based on an alleged abuse of discretion by a district court's denial of a 56(f) request and grant of summary judgment. It is clear from this Court's previous denial of a similar petition that a district court's discretionary refusal to continue a summary judgment motion based on an alleged need for discovery is not such an egregious departure from the usual course of judicial proceedings to warrant this Court's supervisory power.

Petitioners' Brief only argues that the allegedly "egregious" error by the district court was to decide that further discovery was not needed in order for it to decide Amex's motion for summary judgment under the facts of this case. Rule 56(f),

by its terms, affords district courts discretion to order continuance of a summary judgment motion where the party opposing it establishes the need for discovery of facts essential to justify its opposition, or to issue any other just order. The interpretation of this rule is not at issue. Rather, Petitioners merely argue that it was not applied in their favor. As Rule 10 indicates, "erroneous factual findings or the misapplication of a properly stated rule of law" rarely result in a grant of a writ of certiorari. See *United States v. Johnston*, 268 U.S. 220, 227 (1925) ("We do not grant certiorari to review evidence and discuss specific facts."); *Southern Power Co. v. North Carolina Pub. Serv. Co.*, 263 U.S. 508, 509 (1924) (whether evidence was sufficient was primarily a question of fact, not a ground upon which the Court would be moved to grant certiorari).

Petitioners' reference to a single case on this issue does not help them; the language referred to in *Celotex Corp. v. Catrett* was dicta that sets forth the availability of Rule 56(f) but does not require a particular application of it from which the District Court differed. 477 U.S. 317, 326 (1986). In fact, *Celotex* largely stood for the proposition that Rule 56 was designed to facilitate the summary disposition of meritless claims and defenses, despite an opposing party's assertion that the evidence presented was insufficient. *Id.* This Court also specifically declined to address the adequacy of the showing made by the respondent on summary judgment, finding that the courts below were better equipped to do so. *Id.* at 327.

This Court is even more cautious in granting certiorari in a situation where the district court's determination is affirmed by the court of appeals. See *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 275 (1949) ("A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error.") After failing to identify any error in the district court's denial of their 56(f) motion, and failing to persuade the Second Circuit of any abuse of discretion, Petitioners merely seek another bite at the apple. Recycling arguments already rejected by the circuit court has never been a proper basis for certiorari, and such an attempt is disrespectful of this Court's unique and important role. *See Magnum Imp. Co. v. Coty*, 262 U.S. 159, 163 (1923) ("[t]he jurisdiction was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing. Our experience shows that eighty per cent of those who petition for certiorari do not appreciate these necessary limitations upon our issue of the writ.")

Finally, Petitioners do not even attempt to argue that any alleged error by the district court has any application beyond the facts of this case. *National Labor Relations Bd. v. Pittsburgh Steamship Co.*, 340 U.S. 498, 502 (1951) ("Certiorari is granted only in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties") (quoting *Layne & Bowler Corp. v. Western*

Well Works, 261 U.S. 387, 393 (1923)). Such an episodic case, relevant only to a particular private litigant, does not warrant review by this Court.

II. No Discovery was Needed from Respondent on the Ground that the District Court Granted Summary Judgment and Thus Any Alleged Error in Denying Petitioners' 56(f) Motion Was Harmless

Although they did not raise the issue in opposing summary judgment, Petitioners, for the first time before the Second Circuit, and now this Court, insist that further discovery was needed in order to support their misappropriation claim, and therefore summary judgment was premature. Petitioners' insistence, given their own statement that misappropriation claims can exist separately from a trademark infringement claim, is baffling, given that they voluntarily dropped their misappropriation claim before the District Court. *See* App. 20a ("Although Goetz does not formally concede independent creation by American Express, he no longer disputes American Express on this point. The central issue that remains therefore is whether American Express has infringed Goetz's alleged trademark, which in turn depends upon whether Goetz has any trademark rights at all."). Petitioners improperly attempted to re-introduce their misappropriation claim through the back door by appealing the denial of their request for discovery before the Second Circuit; however, again, they did not advance any arguments regarding their misappropriation claim. This Court need not consider,

in the first instance, a claim that was not pursued before or decided by the courts below. *Ariz. Dep't of Revenue v. Blaze Constr. Co.*, 526 U.S. 32, 35 (1999).

Given that Petitioners themselves did not pursue their misappropriation claim, the District Court decided the remaining trademark infringement claims on the ground that there was no evidence that Petitioners used "My Life, My Card" as a trademark prior to Amex. Because first use by Petitioners, not creation by Amex, was the critical date on the trademark infringement claim, it was Petitioners' burden to show that they had first used the disputed mark. No discovery from Amex was required on that issue – the information was exclusively in Petitioners' possession. Therefore, the discovery Petitioners insist they needed to verify the dates of documents showing Amex's independent creation was irrelevant to a claim of trademark infringement, would not have supported either party's remaining claims or defenses, and was properly denied.

Even if the misappropriation claim had remained, as this Court noted in *Celotex*, no discovery is needed by a party opposing summary judgment in order to present facts within its control, or to point to material issues of disputed fact, on summary judgment. 477 U.S. at 324. Moreover, Petitioners' 56(f) request for more discovery was improperly based only on speculative contentions that the affidavits supporting Amex's motion for summary judgment were not credible, without specifying what genuine issue of material facts further discovery would uncover, and was thus properly denied. *See, e.g., Gurary v. Winehouse*,

190 F.3d 37, 43 (2d Cir. 1999) ("a party resisting summary judgment on the ground that it needs discovery in order to defeat the motion must . . . [show] how those facts are reasonably expected to create a genuine issue of material fact. . ."); *Paddington Partners v. Bouchard*, 34 F.3d 1132, 1138 (2d Cir. 1994) (a court can reject a Rule 56(f) request for discovery if it is based on speculation as to what potentially could be discovered); *Ying Gan v. The City of N.Y.*, 996 F.2d 522, 532 (2d Cir. 1993). Finally, if there were any error in the district court's denial of Petitioners' 56(f) motion, it was harmless because it did not preclude Petitioners from pointing to disputed issues of fact regarding their misappropriation or other claims. Petitioners' real gripe is that the courts below found evidence supporting their claims to be insufficient and did not find their alleged disputes over facts to be genuine or material.

In any event, Petitioners' contention that they were deprived "of any opportunity to conduct any discovery" or the right to conduct "some iota of discovery" is a misrepresentation. Amex and Ogilvy filed their motion for summary judgment six months after filing their Complaint, and by then had produced several thousands of pages of documents. Over fifteen of these documents, dated between July 15th and August 1st, established that they had independently conceived of the MLMC mark prior to the earliest date Petitioners' solicitation would have reach Amex. Thus Amex did not "adopt" the mark "a day after it received Goetz's submission" but conceived of it nearly two weeks before. This was verified by

Petitioners' own forensic expert, who examined emails reflecting Amex's consideration of the MLMC mark that existed separately from a computer that had been accidentally erased after documents it had contained were copied to another hard-drive. [Documents attached in support of Respondent's motion for summary judgment were authenticated by affidavit.] The fact that Petitioners do not even identify what further "authentication" or "objectively verifiable forensic discovery" they seek, or how such discovery would change the outcome, reveals that this question is entirely baseless.

CONCLUSION

For the reasons stated, the Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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